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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/512,135	05/03/2005	Manabu Tsumura	12218/41	2391
23838 7590 02/21/2007 KENYON & KENYON LLP 1500 K STREET N.W. SUITE 700 WASHINGTON, DC 20005			EXAMINER ZIMMER, MARC S	
			ART UNIT 1712	PAPER NUMBER
SHORTENED STATUTORY PERIOD OF RESPONSE			MAIL DATE	DELIVERY MODE
3 MONTHS			02/21/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

10/512,135

Applicant(s)

TSUMURA ET AL.

Examiner

Marc S. Zimmer

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 October 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-63 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-6, 8-48 and 50-63 is/are rejected.
- 7) ☒ Claim(s) 7 and 49 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- 1) ☒ Certified copies of the priority documents have been received.
 - 2) ☐ Certified copies of the priority documents have been received in Application No. _____.
 - 3) ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>01/12/05, 03/17/06</u> . | 6) <input type="checkbox"/> Other: _____ |

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 16-22, 31, and 33-59 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claims 16, 22, 31, 33, 39, 41, 43, and 56 all recite a product/component that is "obtainable" from a specified approach or reaction. The word "obtainable" is indefinite because it seems to indicate that there are other synthetic approaches that are embraced by the description that follows and Applicant is merely mentioning one such approach. The word "obtainable" should be replaced with obtained.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-6 and 22-23 are rejected under 35 U.S.C. 102(b) as being anticipated by Sakaguchi et al., JP 9-316293. The abstract associated with this reference discloses a composition that anticipates all aspects of the aforementioned claims except that it says only that component (A) has at least one alkenyl group. Nevertheless a compound

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that is exemplary of component (A) is disclosed in paragraph 35 and this compound adheres to the stipulation that at least two alkenyl groups are present.

Claims 25, 27, 31, and 32 are rejected under 35 U.S.C. 102(b) as being anticipated by Dinallo et al., U.S. Patent 4,943,601. Dinallo teaches a compound comprising all of the materials outlined in the abstract. It is appreciated that, in this instance, the compound (column 6, lines 19-24) corresponding to component (A) is actually meant to fulfill the role of an inhibitor as opposed to a compound that is reacted with the organohydrogensiloxane. It is true, nevertheless, certain embodiments of this compound adhere to formula (II) in claim 25 and the composition is curable. There is no requirement in claim 25 that (A) be reacted with (B).

Claims 1-6 are rejected under 35 U.S.C. 102(b) as being anticipated by Kawamura, U.S. Patent # 5,684,110. The abstract teaches every element of claim 1 except for the presence of a silane coupling agent. However, cursory mention of adhesion promoters is made in column 7, line 34 and the skilled artisan will appreciate that "adhesion promoter" is an art accepted alternative expression for a coupling agent. Each of Examples 1-3 mention 3-glycidoxypropyltrimethoxysilane as a permutation of the adhesion promoter. Organoaluminum catalysts equivalent to those contemplated in claim 6 are disclosed in column 6, lines 28-33.

Claims 1-6, 8-10, 12-13, 16-17, 20, 22-25, 27-29, 31-37, 39-42, 46-48, 50-51, 53-54, 56-59, and 63 are rejected under 35 U.S.C. 102(a) as being anticipated by Ouchi et al., WO 02/053648. U.S. Patent Application Publication No. 2004/0126504 is used as a faithful translation of this document. This document is commonly assigned and contains

many of the same concepts that are presently being claimed. See paragraphs 13-28, 93, 101, 113, 115, the first and third structures depicted on the right side of page 8 and the lone structure in the left column of page 9, paragraphs 178, 187-188, 200, 202, 242-245, and 303 and the paragraphs that follow.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 11, 14-15, 18-19, 21, 26, 30, 38, 43-45, 52, 55, and 60-62 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ouchi et al., WO 02/053648. The reference does not expressly disclose these combinations of (A) and (B) but it is the Examiner's contention that they are obvious combinations in view of the favored permutations of these components as identified by that disclosure. Concerning those claims that are directed to light emitting diodes, the specific orientations of the components that make up the article do not appear to be expressly described but are usual arrangements of their constituent parts familiar to the skilled artisan and/or are obvious from the teachings of paragraphs 303+.

The Examiner notes that this document and numerous others cited by the ISA as "X" references are overcome with a certified translation of Applicant's priority documents. The Examiner has avoided formulating rejections over these other

references inasmuch as they fail to reject any more claims than those already addressed by WO 02/053648 and because the Examiner expects that Applicant will furnish certified translations of said priority papers in order to render them invalid as prior art.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 25, 27, 33, and 34 are provisionally rejected on the ground of nonstatutory double patenting over claims 2, 4, and 7 of copending Application No. 10/433,981. This is a provisional double patenting rejection since the conflicting claims have not yet been patented.

The subject matter claimed in the instant application is fully disclosed in the referenced copending application and would be covered by any patent granted on that

copending application since the referenced copending application and the instant application are claiming common subject matter. Present claims 33 and 34 disclose a compound bearing two silicon-bound hydrogen atoms (B), see formula (III) that overlaps with the crosslinking agent contemplated in claim 2 of the co-pending application. Claim 4 discloses the combination of this compound with the same materials as are contemplated in claims 33 and 34. Claims 25 and 27 are co-extensive in scope with claim 7 which limits component (A) in a fashion that the overlap between components (A) in the claims of this and the co-pending application is evident.

Allowable Subject Matter

Claims 7 and 49 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. Nowhere did the Examiner find a reference that described all of the components of claim 1 and wherein the condensation catalyst was boron-based.

As an aside, the ISA had cited JP 9-291214 as being germane to at least some of the claims. The present Examiner does not believe that this document anticipates any permutations of the invention because a translation of its teachings showed that the materials corresponding to (I) and (II) are not used themselves in a reaction with a compound bearing silicon-bound hydrogen atoms. Rather, they are first polymerized and the product of this polymerization, which contains at some remaining alkenyl group content is what is reacted.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Marc S. Zimmer whose telephone number is 571-272-1096. The examiner can normally be reached on Monday-Friday 8:00-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Randy Gulakowski can be reached on 571-272-1302. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

January 30, 2007



MARC S. ZIMMER
PRIMARY EXAMINER